



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,425	03/16/2004	Jeremy G. Dunne	LT10043	2057
25235 7590 08/29/2007 HOGAN & HARTSON LLP ONE TABOR CENTER, SUITE 1500 1200 SEVENTEENTH ST DENVER, CO 80202			EXAMINER SAGER, MARK ALAN	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 08/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/801,425

Applicant(s)

DUNNE ET AL.

Examiner

M. A. Sager

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 13-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, 23-25, drawn to range finding instrument or method, classified in class 473, subclass 409.
 - II. Claims 13-22, drawn to range finding instrument, classified in class 702, subclass 159 or in class 367, subclass 128.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as range finding instrument and method not requiring the particulars of displaying a suggested aim point, as particularly claimed in subcombination II claims; while, subcombination II has separate utility such as range finding instrument not requiring particulars of providing data indicative of a golf club type and/or computing one other data set indicative of another golf club type, as particularly claimed in subcombination I. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the

Art Unit: 3714

present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction were not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper. Search required for aim point of subcombination II claims is not required for subcombination I claims; while, search required for club type of subcombination I claims is not required for subcombination II.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction were not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Michael Martensen (46901) on August 21, 2007, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-12 and 23-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, as noted during conversation.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-12 and 24-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The first paragraph of 35 U.S.C. 112 requires that the "specification shall contain a written description of the invention." This requirement is separate and distinct from the enablement requirement. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991). See also *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 920-23, 69 USPQ2d 1886, 1890-93 (Fed. Cir. 2004) (discussing history and purpose of the written description requirement); *In re Curtis*, 354 F.3d 1347, 1357, 69 USPQ2d 1274, 1282 (Fed. Cir. 2004) ("conclusive evidence of a claim's enablement is not equally conclusive of that claim's satisfactory written description"). The written description requirement has several policy objectives. "[T]he essential goal' of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed." *In re Barker*, 559 F.2d 588, 592 n.4, 194 USPQ 470, 473 n.4 (CCPA 1977). Another objective is to put the public in possession of what the applicant claims as the invention. See *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), cert. denied, 523 U.S. 1089 (1998). "The written description 'requirement implements the

Art Unit: 3714

principle that a patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed." *Capon v. Eshhar*, 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1084 (Fed. Cir. 2005). Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116. However, a showing of possession alone does not cure the lack of a written description. *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 969-70, 63 USPQ2d 1609, 1617 (Fed. Cir. 2002). Also, a question as to whether a specification provides an adequate written description may arise in the context of an original claim which is not described sufficiently (see, e.g., *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1345, 76 USPQ2d 1724, 1733 (Fed. Cir. 2005); *Enzo Biochem*, 323 F.3d at 968, 63 USPQ2d at 1616 (Fed. Cir. 2002); *Eli Lilly*, 119 F.3d 1559, 43 USPQ2d 1398). In this case, although the written specification mentions computing distances for other clubs (6:1-27, fig 2, step 214); the originally filed written specification fails to provide adequate support for one of ordinary skill that applicants possessed the invention at the time of filing application regarding 'computing at least one other correlated data set indicative of another golf

Art Unit: 3714

club type and associated representative user range based upon a relationship in said first correlated data set' (claim 1, 25) or 'computing at least suggested club type and an associated representative user range for said at least one other club type' (claim 24) in that there is no process, procedure, table, formula, algorithm, or any manner of computing to suggest a club type [based upon computed data set] taught or implied, or inferred without undue experimentation, and such is not inherent. Also, there is no process, procedure, table, formula, algorithm or many of computing disclosed so as to make public aware of scope of claimed computing. Thus, the written specification does not clearly convey the information that an applicant has invented the subject matter that is claimed regarding 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' (claim 1, 25) or 'computing at least suggested club type and an associated representative user range for said at least one other club type' (claim 24). Further, there is no computing based upon a relationship in first data set (claims 1, 25) disclosed, taught and such is not inferred, implicit or inherent. In addition, proposed entry of any process, procedure, table, formula, algorithm, or any other manner to define computing may be viewed as new matter; which is expressly prohibited.

9. Claims 1-12 and 24-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. An invention may be described without the disclosure being enabling (e.g., a chemical compound for which there is no disclosed or apparent method of making), and a disclosure could be enabling without

Art Unit: 3714

describing the invention (e.g., a specification describing a method of making and using a paint composition made of functionally defined ingredients within broad ranges would be enabling for formulations falling within the description but would not describe any specific formulation). See *In re Armbruster*, 512 F.2d 676, 677, 185 USPQ 152, 153 (CCPA 1975) (“[A] specification which describes’ does not necessarily also enable’ one skilled in the art to make or use the claimed invention.”). In this case, although the original written disclosure may disclose computing distances for other clubs (6:1-27, fig 2); the written specification as originally filed fails to teach one of ordinary skill in the art how to make/use the invention regarding ‘computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set’ (claim 1, 25) or computing at least suggested club type and an associated representative user range for said at least one other club type’ (claim 24) without undue experimentation in that the originally filed specification lacks disclosing a process, procedure, table, algorithm, formula or any form of computing so as to suggest a club type and such forms of computing is not implicit, inferred or inherent. In *re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) (“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.”). A patent need not teach, and preferably omits, what is well known in the art. In *re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist &*

Art Unit: 3714

Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). In addition, the originally filed disclosure fails to enable how to make/use the invention regarding computing based upon a relationship in first data set. Also, proposed entry of any process, procedure, table, formula, algorithm, or any other manner to define computing may be viewed as new matter, the entry of such is expressly prohibited.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-12 and 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The cited claims are indefinite for failing to point out and distinctly claim subject matter applicant regards as the invention with respect to computing since it is unclear as to particular process, procedure, table, algorithm, formula used to compute one other/another golf club type and associated range whereby none is inherent, implicit or inferred.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by each Zeiner-Gundersen (6059672) and Jenkins (5294110). Zeiner-Gundersen discloses a device and method teaching entering at least one club type and associated representative user range for said at least one club type to a data store associated with a range finding instrument (2:18-19, 3:39-41 and

Art Unit: 3714

56-57, 5:63-6:2, ref 14); determining a range to a selected point on a golf course with said range finding instrument (4:27-31, 4:61-5:7, 5:19-20); extrapolating a suggested club type appropriate to said determined range from said at least one club type and associated representative user range (2:13-55, 3:6-6:18, esp. 5:23-25); and displaying said suggested club type to a user of said range finding instrument (3:56-4:67, 4:61-5:7, 18-25). Similarly, Jenkins discloses a method of an analyzer and club selector (abstract, 2:27-3:3) teaching entering at least one club type and associated representative user range for said at least one club type to a data store associated with a range finding instrument (2:27-35, 2:65-68, 4:46-48, 5:47-51, 6:1-29); determining a range to a selected point on a golf course with said range finding instrument (abstract, 2:59-64, 6:55-68); extrapolating a suggested club type appropriate to said determined range from said at least one club type and associated representative user range (abstract, 2:27-3:3, 6:64-68); and displaying said suggested club type to a user of said range finding instrument (abstract, 2:27-57, 6:64-68).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 3714

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 1-7, 10-12 and 24-25 are rejected under 35 U.S.C. 103(a) as obvious over Zeiner-Gundersen in view of either Johnstone (3059926) or Mauritz (5283732). While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Zeiner-Gundersen discloses a range finding instrument comprising a user input (abstract, 2:13-55, 5:63-66, fig. 5, ref 14), a data store (implicit microprocessor 20 contains memory), a processor (ref 20), rangefinder (ref 24), a display indicating a suggested golf club type (abstract, 2:13-21, 5:23-25, ref 22), a tilt sensor (3:50-52, ref 30, 32), a wind speed and direction sensor (3:52) but lacks the processor performing claimed function of 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' or 'computing at least said suggested club type and an associated representative user range for said at least one other club type'. However, Johnstone discloses average ranges for each of a particular golf club type (3:19-55); while, Mauritz discloses recommending a particular golf club type for a range based on personal

Art Unit: 3714

data including handicap (abstract, 1:47-2:14, figs. 1-4). Where a golfer/user may not know the personal performance range of a particular golf club type (such as might occur prior to initial use of a golf club type), it would have been obvious to an artisan at a time prior to the invention to add 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' or 'computing at least said suggested club type and an associated representative user range for said at least one other club type' as either a standard range of average user as taught by Johnstone or based on personal performance characteristic such as handicap as taught by Mauritz to Zeiner-Gundersen to permit consideration of a new golf club type. Alternatively, 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' or 'computing at least said suggested club type and an associated representative user range for said at least one other club type' does not solve any Applicant stated problem or purpose, Zeiner-Gundersen discloses instrument containing claimed structure but lacks claimed computing. However, Zeiner-Gundersen would at a time prior to the invention have performed equally as well (i.e. be operative/functional) by adding 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' or 'computing at least said suggested club type and an associated representative user range for said at least one other club type' as either a standard range of average user as taught by Johnstone or based on personal performance characteristic such as handicap as taught by Mauritz so as to permit consideration of a new club type in shot suggestion upon initial club type usage where no personal range performance data is available such that

Art Unit: 3714

basis may be obtained from average golfer performance with a particular club type or based upon personal performance in general. Further, regarding display to indicate said 'angular inclination of said selected point' (clm 5), or 'wind speed and direction' (clm 7) or 'ground condition' (clm 11), Zeiner-Gundersen display indicates claimed 'angular inclination of said selected point' or 'wind speed and direction' or 'ground condition' (abstract, 2:13-55, 4:17-18 and 49-54, 4:61-5:7, 5:18-25) at least as an indication in summary of which club and shot suggestion to play ball based on acquired data and golfer performance. It is noted that claimed 'indicating' or to indicate does not require actual sensor gathered display of wind speed direction, inclination or ground condition, and thus breadth includes and fails to preclude display summation taught by Zeiner-Gundersen as indicating club or shot suggestion based on acquired data for wind, inclination and ground condition where the particular club or shot suggestion is the indication. Alternatively, it is notoriously well known AS BY OFFICIAL NOTICE within computing art to display data to inform user regarding the data and thus it would have been obvious to an artisan at a time prior to the invention to display 'angular inclination of said selected point' or 'wind speed and direction' or 'ground condition' as known in computing art to Zeiner-Gundersen in view of either Johnstone or Mauritz to inform player of acquired/collected data.

17. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeiner-Gundersen in view of either Johnstone (3059926) or Mauritz (5283732) as applied to claim 1 above, and further in view of either Jenkins (5294110) or Jones (4136394). Zeiner-Gundersen in view of either Johnstone or Mauritz discloses claimed instrument (supra) except entering a wind speed and direction at least since Zeiner-Gundersen includes a wind speed and direction sensor. Jenkins and Jones each disclose an instrument teaching user input for entering a wind speed and

Art Unit: 3714

direction for possible alteration of suggested club type based upon determined range. Because Zeiner-Gundersen and either Jenkins or Jones each teach methods of suggesting a club type based upon determined range, it would have been obvious to an artisan at a time prior to the invention to substitute one method for the other to achieve the predictable result of suggested club type based upon determined range as a possible alteration due to wind speed and direction. Thus, it would have been obvious to an artisan at a time prior to the invention to substitute entering wind speed and direction manually as suggested by either Jenkins or Jones to Zeiner-Gundersen in view of either Johnstone or Mauritz to permit possible alteration of suggested club based upon manual estimation of wind speed and direction. Also, regarding scope of display to indicate wind speed and direction is analogous to discussion above regarding display indicating wind speed and direction or inclination or a ground condition that is incorporated herein.

18. Claims 1-5, 8-12, and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins in view of either Johnstone (3059926) or Mauritz (5283732). While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this

Art Unit: 3714

case, Jenkins discloses a range finding instrument comprising a user input (abstract, 2:26-3:3, 3:66-4:8, 4:46-48, 5:48-51, ref 27), a data store (ref. 67, 69, 71, 73), a processor (ref 65), rangefinder (6:55-68), a display indicating a suggested golf club type (abstract, 2:26-3:3, 6:64-68), a tilt sensor (2:50-56, ref 13), entering a wind speed and direction (2:26-3:3, 3:66-4:4, 8:18-51) but lacks the processor performing claimed function of 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' or 'computing at least said suggested club type and an associated representative user range for said at least one other club type'. However, Johnstone discloses average ranges for each of a particular golf club type (3:19-55); while, Mauritz discloses recommending a particular golf club type for a range based on personal data including handicap (abstract, 1:47-2:14, figs. 1-4). Where a golfer/user may not know the personal performance range of a particular golf club type (such as might occur prior to initial use of a golf club type), it would have been obvious to an artisan at a time prior to the invention to add 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' or 'computing at least said suggested club type and an associated representative user range for said at least one other club type' as either a standard range of average user as taught by Johnstone or based on personal performance characteristic such as handicap as taught by Mauritz to Jenkins to permit consideration of a new golf club type. Alternatively, 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' or 'computing at least said suggested club type and an associated representative user range for said at least one other club type' does

Art Unit: 3714

not solve any Applicant stated problem or purpose, Jenkins discloses instrument containing claimed structure but lacks claimed computing. However, Jenkins would at a time prior to the invention have performed equally as well (i.e. be operative/functional) by adding 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' or 'computing at least said suggested club type and an associated representative user range for said at least one other club type' as either a standard range of average user as taught by Johnstone or based on personal performance characteristic such as handicap as taught by Mauritz so as to permit consideration of a new club type in shot suggestion upon initial club type usage where no personal range performance data is available such that basis may be obtained from average golfer performance with a particular club type or based upon personal performance in general. Further, regarding display to indicate said 'angular inclination of said selected point' (clm 5), or 'wind speed and direction' (clm 7) or 'ground condition' (clm 11), Jenkins display indicates claimed 'angular inclination of said selected point' or 'wind speed and direction' or 'ground condition' (abstract, 2:26-3:3) at least as an indication in summary of which club and shot suggestion to play ball based on acquired data and golfer performance. It is noted that claimed 'indicating' or to indicate does not require actual sensor gathered display of wind speed direction, inclination or ground condition, and thus breadth includes and fails to preclude display summation taught by Jenkins as indicating club or shot suggestion based on data for wind, inclination and ground condition where the particular club or shot suggestion is the indication. Alternatively, it is notoriously well known AS BY OFFICIAL NOTICE within computing art to display data to inform user regarding the data and thus it would have been obvious to an artisan

Art Unit: 3714

at a time prior to the invention to display 'angular inclination of said selected point' or 'wind speed and direction' or 'ground condition' as known in computing art to Jenkins in view of either Johnstone or Mauritz to inform player of acquired/collected data.

19. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins in view of either Johnstone or Mauritz as applied to claim 1 above, and further in view of either Zeiner-Gundersen or Wilens (5779566). Jenkins in view of either Johnstone or Mauritz discloses claimed instrument (supra) except a wind speed and direction sensor. However, it is well settled in case law to make a prior manual activity automated. In re Venner et al., 120 USPQ 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.). Zeiner-Gundersen (sic) and Wilens (2:20-5:35, 7:17-27, 10:24-11:4, figs. 1-41, esp. 18-20) each teach an instrument including a wind speed and direction sensor to automatically input wind speed and direction for possible alteration to suggested golf club type based on determined range. Because Jenkins and either Zeiner-Gundersen or Wilens each teach methods of suggesting club type based on determined range and wind speed and direction, it would have been obvious to an artisan at a time prior to the invention to substitute one method for the other or to automate Jenkins method in view of either Johnstone or Mauritz via use of a sensor to automatically obtain a more accurate reading to

Art Unit: 3714

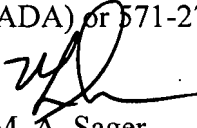
achieve the predictable result of suggested club based on determined range. Also, regarding scope of display to indicate wind speed and direction is analogous to discussion above regarding display indicating wind speed and direction or inclination or a ground condition that is incorporated herein.

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


M. A. Sager
Primary Examiner
Art Unit 3714

mas